

REMARKS

Claims 7-10 have been cancelled, the limitations of these claims incorporated into amended claim 1 and claims 1 and 11 amended to further patentably distinguish the invention from the prior art. The description has been amended to lend antecedent support to some terminology in the amended claims. Such cancellations of and amendments to claims are only for the purpose of expediting the prosecution of this application and are not to be construed as an abandonment of any of the novel concepts disclosed therein.

The courtesy of the Board in reversing final rejections and allowing appellant to furnish further amendments and reasoning in support of patentability is acknowledged with appreciation. Appellant has elected to amend and continue prosecution.

The decision states:

Chen discloses a separable key holder comprising a pair of elongated, preferably flexible and rectangular straps (16, 18), most of one surface of each strap having thereon a patch of hook and loop fastening material (20 or 22) for releasable attachment to the comparable hook and loop fastening material of the other strap (col. 3, ll. 19-25, 35-39). An end of each strap is free of hook and loop fastening material, passes through a circular key holding element (12 or 14), and is folded back upon itself and sealed to itself, preferably by heat sealing, so as to hold the key holding element in looping engagement with the strap (col. 3, ll. 41-54; figs. 1, 2).

Jung discloses a combined nail clipper and key holder comprising an elongated nail clipper container (11), a triangular-shaped connecting member (14), one side of which has a gap in its central portion with a prong on each side of the gap that extends into nail clipper container 11 for fastening connecting member 14 to nail clipper container 11, and a key ring (15) in looping engagement with connecting member 14 (col. 2, ll. 18-22, 45-50; figs. 1, 3).

Momemers discloses a key keeper comprising a D-shaped loop (3) having a U-shaped portion and, between the ends of the U-shaped portion, a bar having a gap (17) therein for receipt of keys onto loop 3 (abstract; col. 2, ll. 39-41; fig. 1). On each side of the gap is a leg (15 or 16) that projects into a cavity in a loop holder (2) (col. 3, ll. 44-47; fig. 1).

The Appellant questions the desirability of combining the references to arrive at the claimed invention (Br. 4-7; Reply Br. 2-3).

As stated by the Supreme Court in *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740-41:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

Chen's key holding elements 12 and 14 are attached directly to straps 16 and 18 without an intervening ring (figs. 1, 2). However, Jung's disclosure of connecting member 14 (col. 2, 11. 45-47) would have led one of ordinary skill in the art, through no more than ordinary creativity, to use an intervening ring in Chen's key holder to provide the readily apparent benefits of rendering the key holding element attachment releasable and permitting multiple key holding elements to be attached to each strap. See *KSR*, 127 S.Ct. at 1741 (In making the obviousness determination one "can take account of the inferences and creative steps that a person of ordinary skill in the art would employ").

Jung's connecting member 14 is not D-shaped. However, Jung does not set forth any significance of the shape of connecting member 14, other than indicating that it must have a bar comprising inwardly extending prongs with a gap there between for attaching connecting member 14 to clipper container 11 (figs. 1, 3). Hence, one of ordinary skill in the art would have been led, through no more than ordinary creativity, to use other shapes that provide inwardly extending prongs, such as Momemers's D-shaped loop 3 (fig. 1).

Although Momemers's loop 3 is a key-retaining loop rather than a connecting member (abstract), one of ordinary skill in the art would have appreciated that the gap in Momemers's loop that is suitable for receiving keys (col. 3, 1. 42) also would be suitable for receiving a key ring. As stated by the Supreme Court in *KSR*, 127 S.Ct. at 1740, "if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill."

Regarding claim 11, Chen's key-holding elements 12 and 14 are attached to straps 16 and 18 preferably by heat sealing, and alternatively by stitching (col. 3, 11. 50-53), not by passing the ends of straps 16 and 18 through a gap in key-holding elements 12 and 14. However, one of ordinary skill in the art would have been

led, through no more than ordinary creativity, by Momemers's disclosures that key-retaining loop 3 has a bar with a gap (abstract; fig. 1) and that keys can be inserted through the gap (abstract; col. 3,1.42; fig.1), to attach Chen's straps 16 and 18 through a gap so that straps 16 and 18 can be releasably attached to the D-ring of the combined disclosures of Chen, Jung and Momemers, and so that the loops at the ends of the straps can be formed in advance by heat sealing or stitching and later attached to key-holding elements 12 and 14.

For the above reasons we are not convinced of reversible error in the rejection of claims 1, 6 and 11 under 35 U.S.C. § 103 over Chen in view of Jung and Momemers. Accordingly, we affirm that rejection. Because our reasoning differs significantly from the Examiner's reasoning, we denominate the affirmance as involving a new ground of rejection. Pp. 8-10

This ground of rejection is respectfully traversed, at least as applied to the claims as amended.

The Board quotes a portion of a paragraph in *KSR Int'l Co. v. Teleflex Inc.*, 127S. Ct. 1727, 1740-41 (2007). The following sentence reads "See *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) ("[R]jections on obvious grounds cannot be sustained by mere conclusory statements, instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness").

In *Ex parte Aylward*, (BPA&I, Appeal No. 2007-2368 December 4, 2007) the Board said in reversing a final rejection,

"Both anticipation under §102 and obviousness under §103 are too-step inquiries. The first step in both analyses is a proper construction of the claims . . . The second step in the analysis requires a comparison of the properly constructed claims to the prior art". *Medichem, S.A. v. Rolabo, SL.*, 353 F. 3d 928, 933 (Fed. Cir. 2003) (internal citations omitted):

A. CLAIM CONSTRUCTION

"The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability if an invention over the prior art." *In re Lowry* 32 F. 3d 1579, 1582 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F. 2d. 1381, 1385 (Fed. Cir. 1983). Slip Op. Pp. 7-8.

In *Ex parte Hamilton* (BPA&I Appeal No. 2007-3091, March 11, 2008) in reversing a final rejection the Board said:

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See *In re Kahn*, 441 F.3d 977, 987-88 (Fed. Cir. 2006), *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991), and *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

The Examiner can satisfy this burden by showing some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Slip Op. Pp. 5-6.

As noted above the PTO must first consider all claim limitations when determining patentability of the invention over the prior art. Claim 1 as amended recites the D-ring coupling the band to the key holding ring having a U-shaped portion engaging the key-holding ring and a bar having bar ends between the U-ends of the U-shaped portion of length corresponding to the distance between the U ends and engaging the band over substantially the entire length of the bar formed with a gap intermediate the U ends of gap width about that of the cross-sectional span of the key-holding ring to allow the key-holding ring to pass through the gap into the D-ring during assembly. The Chen primary reference does not disclose a D-ring coupling a key-holding ring to a band but only discloses the key-holding ring directly connected to the band. The Jung secondary reference does not disclose a D-ring coupling the key-holding ring to the nail clipper container but only discloses a triangular member coupling the key ring to the clipper container that has its two legs bent at each end to form prongs that engage a hole in the clipper container 11 and are separated by a distance much greater than the cross-sectional span of key ring 15.

The Momemers tertiary reference does not overcome the deficiencies of the primary or secondary references. Key retaining loop 3 is not a D-ring. It is clear from the specification and drawing that the D-ring has the shape of the letter D formed by a U portion having ends joined by a bar. Opening 17 has a gap width that bears no relationship to the cross-sectional span of a key ring, the only key ring disclosed in the tertiary reference being loop 3 having a cross-sectional span several times that of gap 17.

It is thus apparent that it is impossible to combine the primary, secondary and tertiary references to form the invention of claims 1, 6 and 11 as amended.

"Moreover, we observe that even if these references were combined in the manner proposed by the examiner, that which is set forth in appellant's claims . . . would not result." *Ex parte Bogar*, slip op. p.7 (BPA&I Appeal No. 87-2462, October 27, 1989). "Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed." *Ex parte Schwarz*, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992). "Although we find nothing before us indicating why it would be desired to combine the references in the manner urged by the examiner, it is clear to us that such a modification by itself would not result in that which is set forth in the claims." *Ex Parte Kusko*, 215 U.S.P.Q. 972, 974 (BPA&I 1981).

That it is impossible to combine the primary, secondary and tertiary references to meet the limitations of amended claims 1, 6 and 11 is reason enough for withdrawing the rejection of them.

It is impossible for the Examiner to satisfy her burden by showing articulated reasoning with some rational underpinning to support the legal conclusion of obviousness, for combining teachings of the primary, secondary and tertiary references would not have suggested to one of ordinary skill in the art to make the invention defined by the active claims as amended.

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.¹⁵ This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."¹⁶ *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1784 (Fed. Cir. 1992).

Accordingly, withdrawal of the rejections of any of the active claims, all of which include the limitations of amended claim 1 as unpatentable over the primary, secondary and tertiary references is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in the references corresponding to each limitation in a rejected claim and the language in the references regarded as motivating a person of ordinary skill in the key holder art to combine what is disclosed in the references to meet the limitations of the rejected claims.

To this end, apart from not providing any motivation to a person of ordinary skill in the art to combine what is disclosed in the three references to meet the limitations of the rejected claims, the inventors in the three patents are inventors of extraordinary skill in the art, and nothing in the disclosures by these inventors of extraordinary skill remotely motivate a person of ordinary skill in the key holder art to combine what is there disclosed to meet the limitations of the rejected claims.

The decision states:

Miller discloses a key holder comprising a strip of material, preferably leather, that is folded over at an end to form a loop through which a key chain passes, is closed by stitching (16) at the other end, and has one snap fastener (28) at each of its side edges intermediate the fold and stitching 16 to fasten together the side edges (p. 1, 11. 32-57; fig. 3).

The Appellant argues that the applied references do not suggest the desirability of the limitations in the Appellant's claims 2, 4, 7 and 9 (Br. 9).

Regarding claim 2, Chen discloses a web (straps 16, 18) looped through key-holding elements 12 and 14 (col. 3, 11. 19-25; figs. 1, 2). Attaching a D-ring to straps 16 and 18 would have been obvious to one of ordinary skill in the art for the reasons given above regarding the rejection of claims 1, 6 and 11.. Like the

Appellant's D-ring, that D-ring would have the ability to rotate through an angle of nearly 360 degrees and would permit rotation of a key-holding ring looped with it to ride along the inside of its U-shaped inside portion for substantially 180 degrees as required by the Appellant's claim 4.

With respect to the requirement of claims 7 and 9 that the key-holding ring is a spiral ring, Chen discloses in figure 4 what appears to be a conventional spiral key ring (12). Also, Jung discloses what appears to be a conventional spiral key ring (15) (fig. 1), and Chen's disclosure of a key holding ring (col. 3, 11. 19-20; figs. 1, 2) would have led one of ordinary skill in the art, through no more than ordinary creativity, to use as the ring any known key holding ring such as the apparently-conventional spiral ring disclosed by Jung.

For the above reasons we are not persuaded of reversible error in the rejection of claims 2, 4, 7, and 9 under 35 U.S.C. § 103 over Chen in view of Jung, Momemmers and Miller. We therefore affirm that rejection. Because our reasoning differs substantially from that of the Examiner, we denominate the affirmance as involving a new ground of rejection. Pp. 11-12.

Since claims 2 and 4 are dependent upon and include all the limitations of amended claim 1, the reasoning set forth above in support of the patentability of claim 1 over the primary, secondary and tertiary references is submitted to support the patentability of claims 2 and 4 adding Miller as a quarternary reference. Accordingly, withdrawal of the rejection of claims 2 and 4 as amended over the primary, secondary, tertiary and quarternary references is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in the references regarded as corresponding to each limitation in claims 2 and 4.

In view of the foregoing amendments, cancellations, authorities and reasoning, all the active claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. Should the Examiner believe the application is not in a condition for allowance, she is respectfully requested to telephone the undersigned attorney at (617) 521-7014 to discuss what steps she believes are necessary to place the application in a condition for allowance.

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Respectfully submitted,
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